

REMARKS

Applicants request reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1-39 are currently pending for the Examiner's consideration, with claims 1, 28, 30-34, and 39 being the independent claims.

Claims 1-27, 23, and 37 are objected to based on informalities. Claims 1, 23, and 37 have been amended to correct these informalities. Applicants respectfully submit that these amendments introduce no new matter. All claim amendments are supported at least by the specification and claims as originally filed.

Claims 1-27 and 30-39 stand rejected under 35 U.S.C. §§ 102(e) and 103(a) as being anticipated by or obvious in view of U.S. Patent Publication No. 2002/0003162 ("the Ferber publication"). Claims 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over an article entitled "The Year of the Thin Client" ("the Year article") in view of official notice taken by the Examiner. For the reasons provided below, Applicants respectfully submit that none of these rejections can properly be maintained, and that the present application is in condition for allowance.

Rejection of Claims 1-27 and 30-39 in view of Ferber publication

Claims 1-27 and 30-39 stand rejected under 35 U.S.C. §§ 102(e) and 103(a) as being anticipated by or obvious in view of the Ferber publication. More specifically, the Examiner has rejected claims 1, 2, 5, 6, 10, 12, 34, 35, and 38 under 35 U.S.C. § 102(e) as being unpatentable over the Ferber publication. The Examiner has also made the following rejections under 35 U.S.C. § 103(a) based on the Ferber publication: claims 3, 4, 7-9, 26, 27, 30-32, 36, 37, and 39 unpatentable over the Ferber publication in view of official notice; claim 11 unpatentable over the Ferber publication in view of U.S. Patent No. 6,144,944 ("the Kurtzman patent"); claims 13 and 14 unpatentable over the Ferber publication in view of an article entitled "Coming Next to Your Local Bank: ATMs That Allow Internet Access?" by Stock ("the Stock article") and official notice; claims 15 and 16 unpatentable over the Ferber publication in view of U.S. Patent No. 5,473,143 ("the Vak patent"); claims 17-19 as unpatentable over the Ferber publication in

view of an article entitled “Wells Fargo to Web-enable 6,300 Machines” by Redman (“the Redman article”); claims 20-25 unpatentable over the Ferber publication in view of an article entitled “Wells Fargo to Web-enable 6,300 Machines” by Redman (“the Redman article”) and official notice; and claim 33 unpatentable over the Ferber publication in view of the Redman article and official notice. Accordingly, each of these rejections is based in whole or in significant part on the Ferber publication.

The Ferber publication is the published document corresponding to U.S. Patent Application Ser. No. 09/835,377 (“the ‘377 Application”), which was filed on April 17, 2001. Applicants note that the ‘377 application claims priority to U.S. Patent Application Ser. No. 60/198,094 (“the Ferber Provisional Application”), which was filed on April 17, 2000. The Section 102(e) date for the Ferber publication is April 17, 2001, the filing date of the ‘377 Application. The Section 102(e) date for the subject matter disclosed in the Ferber Provisional Application is April 17, 2000, the filing date of the Ferber Provisional Application. The present patent application has a filing date of August 10, 2001. The Ferber publication published on January 10, 2002, which is after the filing date of the present patent application. Thus, both the Ferber Provisional Application and the Ferber publication are subject to a declaration of prior invention under 37 C.F.R. § 1.131.

Declarations Under 37 C.F.R. § 1.131

Under 37 C.F.R. § 1.131, the inventors of the subject matter of rejected claims may submit an appropriate declaration to establish conception of the subject matter of the rejected claims prior to the effective date of the reference on which the rejection is based. The showing of facts “shall be such, in character and weight, as to establish...conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice.” 37 C.F.R. § 1.131(b). Attached to this Amendment are declarations under 37 C.F.R. § 1.131 from each inventor of the present application, Calvin H. Fei, Francis George Jacobs, and J. Mark Stockton, that provide a showing of facts sufficient to establish a conception of the claimed invention prior to April 17, 2000, which is prior to the effective date of both the Ferber publication and the Ferber Provisional Application. The declarations under 37 C.F.R. § 1.131 also show due diligence from before April 17, 2000 -- the

filings date of the Ferber Provisional Application -- through August 11, 2000, when an embodiment of the claimed invention was reduced to practice.

Independent claims 1, 30-34, and 39, and claims 2-27 and 35-38 depending therefrom, are directed to a system and methods for presenting a show on an automated teller machine (ATM). As explained in paragraphs 3-6 of the Declaration of Calvin H. Fei Under 37 C.F.R. § 1.131 ("the Fei Declaration"), and as confirmed in the Declaration of Francis George Jacobs Under 37 C.F.R. § 1.131 and the Declaration of J. Mark Stockton Under 37 C.F.R. § 1.131 (collectively, "the Jacobs and Stockton Declarations"), the system and methods of these claims were conceived in the United States prior to April 17, 2000. In particular, as explained in paragraph 5 of the Fei Declaration, features of the invention conceived on or prior to October 7, 1999 are reflected in an October 7, 1999 revision of a document entitled "Web ATM Functional Design Document" ("the October 7, 1999 Design Document"), attached to the Fei Declaration as Exhibit 5.¹

Applicants do not agree that the Ferber publication discloses each of the elements asserted by the Examiner to be disclosed by that reference. Nevertheless, Applicants have prepared a chart, attached as Appendix A, providing exemplary passages from the October 7, 1999 Design Document that disclose each element of the rejected claim that is asserted by the Examiner to be disclosed by the Ferber publication. The chart at Appendix A leads to the conclusion that the October 7, 1999 Design Document discloses, either expressly or inherently, every feature of the claimed invention that is asserted by the Examiner to be disclosed in the Ferber publication.

Applicants respectfully submit that the attached declarations and exhibits establish conception of the claimed invention in this country before April 17, 2000, *i.e.*, before the effective date of both the Ferber publication and the Ferber Provisional Application. Applicants respectfully submit that the attached declarations and exhibits also establish due diligence in this country from prior to April 17, 2000 through August 11, 2000, when an embodiment of the

¹ The October 7, 1999 Design Document, attached as Exhibit 5 to the Fei Declaration, includes a footer that states: "Last revised: 6/8/2006." This "Last revised" message in the footer was automatically date-stamped as a result of printing and preparing the filing of this Amendment and Response, and it does not reflect the date of any actual revision or modification to the content of the document. The content of the document was not modified or revised after October 7, 1999.

invention was reduced to practice. As provided by MPEP § 715.02, for any claims for which there are differences between the claimed invention and what was shown in the attached declarations and accompanying exhibits, either (1) the attached declarations and exhibits establish the basic inventive concept of the claim, or (2) those differences would have been obvious to one of ordinary skill in the art, in view of the attached declarations and exhibits, prior to April 17, 2000. M.P.E.P. § 715.02. In addition, as explained in paragraphs 7-9 of the Fei Declaration, and as confirmed by the Jacobs and Stockton Declarations, Applicants and their representatives exercised due diligence to reduce to practice an embodiment of the invention of independent claims 1, 30, 34, and 39 and dependent claims 2-27 and 35-38 from before April 17, 2000 through August 11, 2000, when the embodiment was reduced to practice.

Therefore, under 37 C.F.R. § 1.131, the Ferber publication and the corresponding Ferber Provisional Application have been removed as references with respect to the present application. Because all rejections of claims 1-27 and 30-39 are based in whole or in significant part on the Ferber publication, all rejections of these claims have been rendered moot.

Footer shows

Rejection of claims 28 and 29 in view of “Year” article

Independent claim 28 and dependent claim 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over an article entitled “The Year of the Thin Client” (“the Year article”) in view of official notice taken by the Examiner. The Examiner asserts that the Year article discloses various recitations of claims 28 and 29. However, as the Examiner notes, the Year article “does not expressly disclose receiving input from a user, wherein said input consists of a PIN and a transaction mode entered by a user in response to instructions displayed on a single display screen.” Office Action, page 12. The Examiner takes official notice that “it is well known for ATMs to receive a PIN and transaction mode as input from a user in response to displayed instructions.” *Id.* The Examiner concludes that “it would have been obvious to one of ordinary skill in the art . . . to receive such input and dispense the case, for the obvious advantage of enabling the ATM to carry out its basic functions as an ATM.”

However, the Year article does not disclose or suggest the claim element “wherein said input consists of a personal identification number and a transaction mode entered by said

user in response to instructions displayed on a single display screen,” as recited in claim 28 and incorporated by reference in claim 29. (Emphasis added.) The Examiner has not asserted that this claim element is either disclosed or suggested in the prior art, nor has the Examiner asserted that this element was known to those of ordinary skill in the art. Thus, Applicants respectfully submit that the rejection of claims 28 and 29 is improper and should be withdrawn.

Objection to Claims 1-27, 23, and 37

The Examiner objected to claims 1-27, 23, and 37 based on various informalities. As suggested by the Examiner, Applicants have amended independent claim 1 and dependent claims 23 and 37 to overcome these objections. Accordingly, Applicants respectfully request that these objections be withdrawn.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: September 20, 2006

Respectfully submitted,

By 
Paul J. Berman
Registration No.: 36,744
Thomas D. Bradshaw
Registration No.: 51,492
COVINGTON & BURLING
1201 Pennsylvania Avenue, N.W.
Washington, DC 20004-2401
(202) 662-6000
Attorneys for Applicant